



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Austin M. Long III et al.

Serial No.: 10/077,174

Filed: February 15, 2002

For: PROCESS AND SYSTEM FOR
DETERMINING CORRELATION OF
PUBLIC AND PRIVATE MARKETS AND
RISK OF PRIVATE MARKETS

Group Art Unit: 3624

Examiner: Richard Weisberger

Atty. Dkt. No.: ALI515/4-3

Confirmation No.: 9524

CERTIFICATE OF MAILING

I, certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

December 19, 2005
Date


Timothy S. Corder

PRE-APPEAL BRIEF REQUEST FOR A PANEL REVIEW

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed concurrently with a Notice of Appeal in the captioned application.

REASONS FOR REQUESTING REVIEW

The final office action rejects claim 15 as being directed to unpatentable subject matter under 35 U.S.C. §101 for overlapping two statutory classes of invention contrary to *Ex parte Lyell*.

Appellants assert that the rejection is in error because the rejection is not directed to the rejected claim, but rather discusses a claim to a completely different technology than rejected

claim 15, as discussed in the Response to Final Action filed September 16, 2005, pg 8, 1st paragraph. Furthermore, the facts of *Ex parte Lyell* are not relevant to claim 15 as discussed in the 2nd paragraph of page 8 in the same response filed September 16, 2005 because claim 15 is directed to a system comprising electronic means for a series of determinations and not to a tool and method of using the same.

Appellants assert therefore that this is an improper rejection and that the rejection of claim 15 under §101 should be withdrawn.

The final action further rejects claims 2-15 under 35 U.S.C. §112 for failing to comply with the written description requirement.

Appellants assert that the Specification contains more than adequate written description for the claimed subject matter. An explanation is contained in the Response to Final Office Action of September 16, 2005, in the last paragraph of page 9 and the first paragraph of page 10. In the response Appellants point to paragraph [00020] of the specification for specific support of the electronic system, including a system for evaluation of private investments including a central processing unit or CPU (processor), which may be a main-frame computer connected to one or more work stations, or it may be a component of a personal computer that may be a "stand alone" computer or it may be networked to other computers though a common server. The system also includes an input device such as a keyboard in communication with the processor, at least one memory source and software including instructions. The device may also include a display device such as a monitor in communication with the processor.

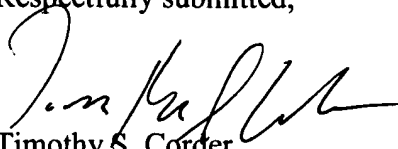
Neither is claim 15 a single means claim, as the electronic means itself encompasses a combination of means, thus distinguishing the claim from *In re Hyatt*.

PATENT

Appellants assert therefore, that the Specification fully meets the Written Description requirement and that all rejections under §112 should be withdrawn.

In light of the foregoing, Appellants respectfully request withdrawal of all rejections and immediate allowance of the existing claims.

Respectfully submitted,



Timothy S. Corder
Registration. No. 38,414
Agent for Applicant

VINSON & ELKINS L.L.P.
First City Tower
1001 Fannin Street
Suite 2300
Houston, Texas 77002-6760
Ph: 512.542.8446

Date: December 19, 2005